

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow.

Claims 23-25, 27-34, 36-42 and 46-48 are pending in the application.

By the above amendments, claims 46 and 48 are amended to correct the typographical error in the definition of variables $c + d$. In addition, claim 40 is amended by replacing the words "characterized in that" with --wherein--. As none of these amendments narrow the scope of the claims, claims 46, 48 and 40 should be accorded their full range of equivalents.

Applicants thank the Examiner for withdrawing the previous rejections.

Turning now to the Official Action, claims 46 and 48 stand objected to for including informalities. In order to obviate the objection, Applicants have amended claims 46 and 48. In particular, Applicants have amended claims 46 and 48 by replacing " $3 < a + b < 10$ " with $--3 < c + d < 10--$.

Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

Claim 40 stands objected to under 37 C.F.R. §1.75(c), as being in improper dependent form. For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action asserts that claim 39 requires devolatilizing and as such "this claim, specifically the absence of a solvent, fails to further limit claim 39." Applicants submit, however, that the disclosure at page 16, lines 11-18, suggests that claim 40 is an appropriate dependent claim. That is, it appears from the

disclosure at page 16 that the process can include a final step of devolatilizing a functionalized oil and that the process can be carried out in bulk, meaning that the reaction between the polyorganohydrosiloxane and the synthon can be carried out in the absence of a solvent or, alternatively, using one of a variety of known solvents, such as those listed in lines 16-18 on page 16. Clearly, this reaction, with or without solvent, is unrelated to the devolatilization of the resulting functionalized oil. Thus, it does not appear that an amendment is needed to comply with the requirements of §1.75(c). If, however, the Examiner still believes that an amendment is needed, Applicants would be pleased to consider any explanation the Examiner may have to support this belief.

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the objection to claim 40 under 37 C.F.R. §1.75(c).

Claim 47 stands rejected under 35 U.S.C. §102(b) over Bailey (U.S. Patent No. 2,970,150). Additionally, claims 23-25, 27-34, 36-40, 42 and 46-48 stand rejected under 35 U.S.C. §103 over Bailey. For at least the reasons that follow, withdrawal of these rejections is in order.

Upon reviewing the Official Action at, for example, paragraph 6, page 3, Applicants note that the Official Action relies heavily on the disclosure of Example 15 of Bailey. In particular, it is asserted that Example 15 shows "a reaction between a synthon as required by claim 47 and a polyorganohydrosiloxane in the presence of a platinum on alumina catalyst." Upon reviewing Example 15, however, Applicants note that the Example describes preparation of a silane. (Emphasis added.) In stark contrast, claim 47 is directed to the preparation of silicone oils, which means that it is directed to a polyorganosiloxane. (Emphasis added.) Applicants submit that it is

well known in the field that a silane cannot be compared to a silicone (or polyorganosiloxane) oil. Furthermore, Applicants note that Example 15 is the only Example in Bailey that deals with epoxy species. Thus, Applicants submit that Example 15, directed to the synthesis of an epoxy silane, cannot anticipate or render obvious the claims of the present application. In addition, Applicants wish to point out that the definition of $a + b > 5$ excludes silanes. Applicants position is even further emphasized by Table VI, which summarizes all of the Examples, wherein only one of the Examples deals with an epoxy species, which is of course a silane.

In addition, Applicants note that Bailey teaches a process that uses an unsaturated compound.

For at least the above reasons, Applicants submit that Bailey is not relevant to the claimed invention, and, thus, cannot be relied upon to support an anticipation or obviousness rejection of the pending claims. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 34 and 36-38 stand rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Crivello (U.S. Patent No. 6,124,418). For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action asserts that Crivello teaches a method of making an epoxy siloxane by means of hydrosilation. The Official Action further asserts that the process of Crivello differs from that claimed in that it does not teach the heterogeneous catalyst as claimed, but that it does teach that the catalyst used results in a final product that does not gel. Thus, the Official Action asserts that

while the processes are different, it "appears that the products are inherently the same." (Emphasis added.)

From these assertions, it is apparent that the Official Action takes the position that Crivello inherently anticipates or renders obvious the subject matter of claims 34 and 36-38. For at least the reasons that follow, Applicants respectfully disagree.

In order for prior art to anticipate a claimed invention on the ground that a limitation is inherently disclosed in the reference, the inherency must be certain. (Emphasis added.) The fact that a prior art reference may have the characteristics of the claimed product is not sufficient. (Emphasis added.) Inherency must be a necessary result and not merely a possible result; the mere fact that a certain thing may result from a given set of circumstances is not enough. (Emphasis added.)

See In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981); and Ex Parte Keith and Turnquest, 154 U.S.P.Q. 320, 321 (Pat. Off. Bd. App. 1966).

Accordingly, the Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the belief that the limitation is an inherent characteristic of the prior art. See Ex Parte Skinner, 2 U.S.P.Q. 2d 1788, 1789 (Bd. Pat. App. & Int. 1986). Certainly, the Official Action's language "it appears that the products are inherently the same," suggests that the asserted inherency is not a necessary result but is recognized as merely a possible result. (Emphasis added.) As explained above, however, the mere fact that a certain thing may result is not sufficient to support an inherent anticipation rejection. (Emphasis added.)

With respect to the inherent obviousness rejection, Applicants submit that the Official Action fails to establish that the product of Crivello would "inherently" be the same as the claimed non-turbid functionalized silicone oil. In order to establish a

prima facie case, it is incumbent on the Patent Office to establish the asserted inherency. See In re King, 231 U.S.P.Q. 136 (Fed. Cir. 1986). The Official Action must provide a basis in fact and or technical reasoning to reasonably support the assertions that the allegedly inherent characteristics of the Crivello product necessarily flows from the teachings of Crivello. (Emphasis added.) See Ex Parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (PTO Bd. App. & Int. 1990).

Absent some additional teaching that establishes that the Crivello product does necessarily include the features of the claimed silicone oil, the Official Action fails to establish the asserted inherent properties of the Crivello product. (Emphasis added.) Moreover, any such additional teaching relied upon for the purpose of establishing inherency of the Crivello product, "must make clear that the missing descriptive matter is necessarily present in the thing [the Crivello product] described in the reference, and that it would be so recognized by persons of ordinary skill." (Emphasis added.) See Continental Can Co. v. Monsanto Co., 20 U.S.P.Q. 2d 1746, 1749 (Fed. Cir. 1991). No such additional teaching is presented in the Official Action. In fact, the language "it appears that the products are inherently the same," set forth in the Official Action, provides clear evidence that the Patent Office does not believe that the Crivello product necessarily includes the features of the claimed silicone oil.

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the inherent anticipation and obviousness rejections of claims 34 and 36-38 over Crivello.

Claims 23-25, 27-34, 36-40, 42 and 46-48 stand rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-16 of U.S.

Patent No. 6,545,115. Applicants respectfully request that this rejection be held in abeyance until an indication of allowable subject matter has been made. Once such an indication has been made, Applicants will be able to determine if a response to the double patenting rejection is warranted.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

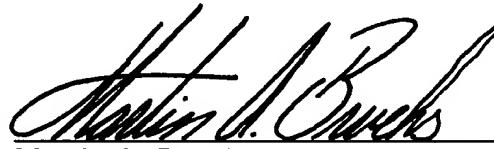
If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

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